

**REMARKS**

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

No claims have been amended in this Response.

Claims 1-20 remain pending in this application.

Reconsideration of Claims 1-20 is respectfully requested.

**I. REJECTION UNDER 35 U.S.C. § 102**

The Office Action rejects Claims 1-18 under 35 U.S.C. § 102(b) as being anticipated by PCT Application WO 98/22897 to Lesaint *et al.* ("*Lesaint*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. §102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The *Lesaint* reference describes a method and apparatus for optimizing the allocation of a plurality of resources to a plurality of tasks. *See Lesaint, p. 1, lines 3-5.* The resources allocated in *Lesaint* are technicians, who have characteristics such as geographical location and skills. *See Lesaint, Fig. 1, Ref. Num. T1-T3; Figs. 3 and 4, Ref. Num. 33; p. 7, lines 23-25.* The elements of the

system taught in the *Lesaint* reference are technicians, tasks and a resource allocation system. See *Lesaint*, Fig. 1; p. 9, lines 15-23.

Regarding independent Claims 1, 7 and 13, the claims recite a process system having a “plurality of resources comprising human resources and process resources” and “comprising a plurality of application processes.” The claims also recite a memory storing a model having a mathematical representation of the application processes, human resources and process resources. The Applicant respectfully submits that the *Lesaint* reference teaches only human resources. The Applicant is unable to find in the *Lesaint* reference any description of a process system having process resources or comprising a plurality of application processes. Furthermore, while Fig. 4 and page 16, lines 3-9, of the *Lesaint* reference describe the storage of technician status, schedule status, a pool of work (tasks), and weighting parameters, the Applicant is unable to find any description of a mathematical model of application processes and process resources.

As such, the *Lesaint* reference does not teach a process system having a “plurality of resources comprising human resources and process resources” and “comprising a plurality of application processes,” as recited in independent Claims 1, 7 and 13. For these reasons, the Office Action has not established that *Lesaint* anticipates the Applicant’s invention as recited in independent Claims 1, 7 and 13 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the §102 rejection and full allowance of Claims 1-18.

## II. REJECTIONS UNDER 35 U.S.C. § 103

The Office Action rejects Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over *Lesaint* in view of U.S. Patent No. 5,140,537 to Tullis (“*Tullis*”). The Office Action also rejects Claim 20 under 35 U.S.C. § 103(a) as being unpatentable over *Lesaint* in view of U.S. Patent No. 5,995,937 to DeBusk *et al.* (“*DeBusk*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness,

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

As described in response to the § 102 rejection of Claims 1-18, the *Lesaint* reference fails to teach all the claim limitations of independent Claim 13. The Applicant respectfully submits that neither the *Tullis* reference nor the *DeBusk* reference overcomes the shortcomings of the *Lesaint* reference. Claims 19 and 20 depend from independent Claim 13 and contain all of the unique and non-obvious limitations recited in the base claim. As such, Claims 19 and 20 are patentable over the combination of the *Lesaint*, *Tullis* and *DeBusk* references. Thus, the Applicant respectfully requests that the rejection of Claims 19 and 20 under 35 U.S.C. § 103 be withdrawn and that Claims 19 and 20 be passed to allowance.

### III. CONCLUSION

For the reasons given above, the Applicant respectfully requests reconsideration and full allowance of all pending claims and that this application be passed to issue.

**SUMMARY**

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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